



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/215,257	12/18/98	FIRE	PM256628

PILLSBURY MADISON & SUTRO
INTELLECTUAL PROPERTY GROUP
1100 NEW YORK AVENUE NW
NINTH FLOOR EAST TOWER
WASHINGTON DC 20005-3918

HM22/0329

EXAMINER

CAMPELL, B

ART UNIT

PAPER NUMBER

1632

DATE MAILED: 03/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

9/215,257

Applicant(s)

Fire et al

Examiner

Campbell

Group Art Unit

1632

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-39 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-39 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 1632

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, 8-23, 25-35 and 39, drawn to methods for inhibiting gene expression in animals, classified in class 514, subclass 44 (claim 35 was assumed to depend on claim 33).
- II. Claims 1-5, 7, 10-18, 21, 22, 24, 28-31, 34 and 39, drawn to methods for inhibiting gene expression in plants, classified in class 514, subclass 44.
- III. Claims 36 and 37, drawn to transgenic animals, classified in class 800, subclass 13.
- IV. Claims 36 and 38, drawn to transgenic plants, classified in class 800, subclass 295.

Claims 1-5, 10-18, 21, 22, 28-31, 34 and 39 are generic to groups I and II. Should either of groups I or II be elected, the generic claims will be examined to the extent that they encompass the elected subject matter. Claim 36 is generic to groups III and IV. Should either of groups III or IV be elected, claim 36 will be examined to the extent that it encompasses the elected subject matter.

The inventions are distinct, each from the other because:

Groups I and II are distinct from groups III and IV because transient inhibition of gene expression is a different concept from production of transgenic organisms. Different starting materials and procedures are used, and successful production of transgenic organisms would not be predictive of success in transiently inhibiting gene expression with applied RNA, nor would success in transiently inhibiting gene expression be predictive for successfully producing a transgenic organism with the desired phenotype. Furthermore, the methods of I and II are not required to make or use the organisms of III and IV, nor are the organisms of III and IV required to practice the methods of I and II. Therefore the inventions are deemed patentably distinct.

Groups I and III are distinct from groups II and IV because plants and animals, as well as methods for inhibiting gene expression in plants and animals, require different searches. Different methods are used for delivering nucleic acids to animals and plants, and for producing transgenic animals and plants. Due to

Art Unit: 1632

the anatomical and physiological differences between animals and plants, neither would render the other obvious, nor would either method render the other obvious. Therefore the inventions are deemed patentably distinct.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce Campell, whose telephone number is 703-308-4205. The examiner can normally be reached on Monday-Thursday from 8:00 to 4:30 (Eastern time). The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jasmine Chambers, can be reached on 703-308-2035. The FAX phone numbers for group 1600 are 703-308-4242 and 703-305-3014.

An inquiry of a general nature or relating to the status of the application should be directed to the group receptionist whose telephone number is 703-308-0196.



**BRUCE R. CAMPELL
PRIMARY EXAMINER
TECHNOLOGY CENTER 1600**